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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/887,833	06/21/2001	Robert Seseek	10006174-1	7851

7590 06/16/2004

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

VAUGHN, GREGORY J

ART UNIT	PAPER NUMBER
2178	

DATE MAILED: 06/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/887,833

Applicant(s)

SESEK, ROBERT

Examiner

Gregory J. Vaughn

Art Unit

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Application History

1. This action is responsive to the application filing, Application filed on 6/21/2001.
2. Applicant filed Information Disclosure Statement on 6/21/2001.
3. Claims 1-25 are pending in the case, claims 1, 7, 12, 15, 16, 18, 19, 20, 21 and 23 are independent claims.

Specification

4. The use of the following trademarks has been noted in this application:
 - "Windows" on page 4, line 17.
 - "Microsoft" on page 4, line 18.
 - "IBM" on page 4, line 20.
 - "Bluetooth" on page 6, lines 19, 21 and 26.
 - "Infrared" on page 6, line 19.

It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner, which might adversely affect their validity as trademarks.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

"The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention. "
6. Claims 4, 22, 24 and 25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
7. **Regarding claim 4**, the claim recites the limitation: *"the mobile computing device"* (page 12, line 16). There is insufficient antecedent basis for this limitation in the claim. Claim 4 is dependent upon claim 1. Claim 1 fails to disclose a *"mobile computing device"* limitation.
8. **Regarding claim 22**, the claim recites: *"the method of claim 21"* (page 16, line 9). There is insufficient antecedent basis for this limitation in the claim. Claim 22 is dependent upon claim 21. Claim 21 is directed toward *"A computer-readable medium"*.
9. **Regarding claim 24**, the claim recites: *"the method of claim 23"* (page 16, line 19). There is insufficient antecedent basis for this limitation in the claim. Claim 24 is dependent upon claim 23. Claim 23 is directed toward *"A computer-readable medium"*.
10. **Regarding claim 25**, the claim recites: *"the method of claim 23"* (page 16, line 23). There is insufficient antecedent basis for this limitation in the claim. Claim 25 is

dependent upon claim 23. Claim 23 is directed toward "A computer-readable medium".

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

"A person shall be entitled to a patent unless –

(e) The invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language."

12. Claims 1-7, 9, 10, 15, 18, 21-23 and 25 are rejected under 35 U.S.C. 102(e) as being anticipated by Murphy US Publication 2002/0033961, filed 6/11/2001, published 3/21/2002.

13. **Regarding independent claim 1**, Murphy recites: *"It is a still further object of the present invention to provide a device that can be easily connected to standard class 1, 2, and 3 fax machines, optical scanners and screen capture methods to convert the image data stream to TCP and UDP enabled format for direct IP address transmission/reception with similarly equipped fax machines, printers, image rendering machines and capable computer terminals over the Internet"* (page 3,

paragraph 29). Murphy further discloses in Figure 3, an address book (at reference sign 32) located externally from the document sender (shown as "Facsimile Machine" at reference sign 14).

14. **Regarding dependent claims 2 and 4**, Murphy recites: "A PCMCIA *"Personal Computer Memory Card International Association"* card slot 206 also is provided. Slot 206 defines a 68-pin interface in accordance with current JEIDA PCMCIA standards with respect to physical and electrical specifications. Thus, Type I, Type II and Type III PCMCIA cards can be used with the present invention. Such cards include flash memory, RAM, and ROM, modem devices, LAN adapters, cellular telephone communication devices and mass storage devices such as miniature hard disk drives" (page 7, paragraph 106)
15. **Regarding dependent claim 3**, Murphy discloses a digital document-sending device in Figure 2 at reference sign 14 (described as a "fax machine" on page 4, paragraph 56).
16. **Regarding dependent claim 5**, Murphy recites: "The remote facsimile machine contains a receiver section 510" (page 1, paragraph 11).
17. **Regarding dependent claim 6**, Murphy recites: "It is a still further object of the present invention to provide a device that can be easily connected to standard class 1, 2, and 3 fax machines, optical scanners and screen capture methods to convert the image data stream to TCP and UDP enabled format for direct IP address transmission/reception with similarly equipped fax machines, printers, image

rendering machines and capable computer terminals over the Internet" (page 3, paragraph 29). Murphy further discloses in Figure 3, an address book (at reference sign 32) located externally from the document sender (shown as "*Facsimile Machine*" at reference sign 14).

18. **Regarding independent claim 7**, Murphy recites: "*It is a still further object of the present invention to provide a device that can be easily connected to standard class 1, 2, and 3 fax machines, optical scanners and screen capture methods to convert the image data stream to TCP and UDP enabled format for direct IP address transmission/reception with similarly equipped fax machines, printers, image rendering machines and capable computer terminals over the Internet*" (page 3, paragraph 29). Murphy further discloses in Figure 3, an address book (at reference sign 32) located externally from the document sender (shown as "*Facsimile Machine*" at reference sign 14).
19. **Regarding dependent claim 9**, Murphy recites: "*In state of the art facsimile machines, the transmitter section 500 (see FIG. 10) typically includes a scanner device 501 which scans the page to be transmitted*" (page 1, paragraph 9).
20. **Regarding dependent claim 10**, Murphy discloses in Figure 4, at reference sign 54, a "*Buffer Address Storage*".
21. **Regarding independent claim 15**, the claim is directed toward a system for the method of claims 1 and 2 combined, and is rejected using the same rationale.

22. **Regarding independent claim 18**, Murphy discloses in Figure 3, an address book of electronic document receivers (reference sign 32), and an external retrieval mechanism (at reference sign 16).
23. **Regarding claims 21 and 22**, the claims are directed toward a computer readable medium for the method of claims 1 and 2 respectively, and are rejected using the same rationale.
24. **Regarding claims 23 and 25**, the claims are directed toward a computer readable medium for the method of claims 7 and 9 respectively, and are rejected using the same rationale.

Claim Rejections - 35 USC § 103

25. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

"a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made."

26. Claims 8, 12, 13, 16, 17, 19, 20 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murphy.
27. **Regarding dependent claim 8**, Murphy discloses sending documents with addresses imported from mobile computing devices as described above. Murphy

fails to explicitly describe importing the addresses using a wireless communication technique. However, Murphy indicates the use of wireless communications. Murphy recites: *"It is a still further object of the present invention to provide a method and apparatus for implementing the present invention over land line as well as wireless network architectures"* (page 3, paragraph 38).

Therefore, it would have been obvious, to one of ordinary skill, at the time the invention was made to use wireless transfer of address information to provide *"an economical device that can be easily connected to present class 1, 2, and 3 fax machines, optical scanners and screen capture methods and that will enable them to communicate over internet global area packet switched networks"* (Murphy, page 2, paragraph 25).

28. **Regarding independent claim 12**, Murphy recites: *"In state of the art facsimile machines, the transmitter section 500 (see FIG. 10) typically includes a scanner device 501 which scans the page to be transmitted"* (page 1, paragraph 9). Murphy discloses a user interface in Figure 10 at reference sign 94. Other limitations of the claim are directed toward a device for the method of claims 1, 3 and 8 combined, and are rejected using the same rationale.

29. **Regarding dependent claim 13**, Murphy discloses a digital document-sending device in Figure 2 at reference sign 14 (described as a *"fax machine"* on page 4, paragraph 56). Murphy discloses a user interface in Figure 10 at reference sign 94.

30. **Regarding independent claim 16**, the claim is directed toward an interface for the device of claim 12, and is rejected using the same rationale.
31. **Regarding dependent claim 17**, the claim is directed toward an interface for the method of claim 10, and is rejected using the same rationale.
32. **Regarding independent claim 19**, the claim is directed toward a device for the method of claims 4, 6 and 8 combined, and is rejected using the same rationale.
33. **Regarding independent claim 20**, the claim contains substantially the same subject matter as claim 12, and is rejected using the same rationale.
34. **Regarding dependent claim 24**, the claim is directed toward a computer readable medium for the method of claim 8, and is rejected using the same rationale.
35. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Murphy in view of Siitonen et al. US Patent 6,049,796, filed 2/24/1997, patented 4/11/2000 (hereinafter Siitonen).
36. **Regarding dependent claim 11**, Murphy discloses sending documents with addresses imported from mobile computing devices as described above. Murphy fails to disclose erasing an electronic address. Siitonen teaches erasing addresses. Siitonen recites: *"The contact application is used to create, edit, delete and manage all information, such as phone numbers and address data"* (column 5, lines 21-23).

Therefore, it would have been obvious, to one of ordinary skill, at the time the invention was made to combine Murphy's document sending method with the address eraser process of Siitonen in order to provide a fully functional and robust "PDA and telephone applications" (Siitonen, column 1, lines 53-54).

37. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Murphy in view of Besprosvan. US Publication 2002/0124057, filed 3/5/2001, published 9/5/2002.

38. **Regarding dependent claim 14**, Murphy discloses a document-sending device with addresses imported from mobile computing devices as described above. Murphy fails to disclose the use of a distribution list. Besprosvan teaches the use of a distribution list. Besprosvan recites: "*The sixth operational feature relating to Web browser access respecting the address book is "group lists." The user is able to create group distribution lists. Group lists allow for message distribution to selected fax and/or e-mail entries in the group*" (page 6, paragraph 84).

Therefore, it would have been obvious, to one of ordinary skill, at the time the invention was made to combine Murphy's document sending with the distribution list as taught by Besprosvan, in order to provide "a unified communications system to integrate telephone, facsimile, and e-mail communications, as well as communications through document dissemination and video or other digital communication technique" (Besprosvan, page 1, paragraph 1).

Conclusion

39. The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

<u>Patent/Publication</u>	<u>Date</u>	<u>Inventor</u>
• US-6,721,286	04-2004	Williams et al.
• US-2001/0034747	10-2001	Fujitani et al.
• US-2002/0036792	03-2002	Murphy, Frederick J.
• US-2002/0036791	03-2002	Murphy, Frederick J.

40. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory J. Vaughn whose telephone number is (703) 305-4672. The examiner can normally be reached Monday to Friday from 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather R. Herndon can be reached at (703) 308-5186. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2178

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gregory J. Vaughn
June 10, 2004


STEPHEN S. HONG
PRIMARY EXAMINER